

EXPEDITED PROCEDURE REQUESTED UNDER 37 C.F.R. § 1.116

Applic. No. 10/083,822

Docket No. 01-1004

REMARKS

In the Office Action mailed July 31, 2003, the Examiner rejected claim 1 under 35 U.S.C. § 112, second paragraph as being indefinite because “the term ‘non-persistent communication channel’ is not clearly defined,” and for insufficient antecedent basis of the term “the user;” rejected claims 1-16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,564,261 to Gudjonsson et al. (“Gudjonsson”); and rejected claim 17 under 35 U.S.C. § 103(a) as being obvious over Gudjonsson in view of U.S. Patent No. 6,584,122 to Matthews et al. (“Matthews”).

Summary of this Response

By this amendment, Applicants have amended claims 1, 5, 9, 13, and 17 to more particularly point out and distinctly claim the subject matter which Applicants regard as their invention, rendering moot the Examiner’s rejection of claim 1 under 35 U.S.C. § 112. In light of the following remarks, Applicants respectfully request the timely reconsideration and allowance of the present application.

Detailed Response

Rejections under Section 112

By this amendment, Applicants propose to amend claim 1 to change “the user” to “a user,” thus mooting the Examiner’s rejection under 35 U.S.C. § 112, second paragraph for improper antecedent basis. Furthermore, Applicants propose to amend claim 1 to remove the term “non-persistent,” thus obviating the Examiner’s rejection under 35 U.S.C. § 112, second paragraph. Applicants further propose to remove this same term (“non-persistent”) from claims 5, 9, 13, and 17. Accordingly, Applicants respectfully request withdrawal of the Examiner’s rejections under 35 U.S.C. § 112.

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Rejections under 35 U.S.C. § 102(e)

Applicants respectfully traverse the rejections of claims 1-16 as being unpatentable under 35 U.S.C. § 102(e), since the cited reference does not teach each and every element of the claim in issue, either expressly or under principles of inherency, as required by 35 U.S.C. § 102(e). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the claim.” See M.P.E.P. § 2131(8th Ed. Aug. 2001), *quoting* Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236 (Fed. Cir. 1989). Finally, “[t]he elements must be arranged as required by the claim.” M.P.E.P. § 2131 (8th Ed. 2001). Applicants submit that these requirements have not been met for at least the following reasons.

Independent claim 1 recites a combination including, for example, “configuring a connection for the at least one communication device based on information in the message.” The Examiner has alleged that Gudjonsson anticipates this claim; Applicants disagree. Gudjonsson teaches a “system/ network [that] acts as a broker(s), and can broker communication service between two or more people.” *See* Col. 7, lines 53-54. It accomplishes this by allowing a user to send an invitation, which “is basically a request from one user 7 to another to join him/ her in some given type of communication.” *See* Col. 9, lines 8-10. While Gudjonsson does provide a “routing service, that allows users to send requests (i.e., invitations for communication sessions to other users, as well as configure how these invitations are handled,” this does not constitute “configuring a connection for the at least one communication device based on information in the message,” as recited in claim 1. In short, the invitation to join a communication session is not a connection. Accordingly, configuring how that invitation is sent cannot constitute “configuring a connection for the at least one communication device based on information in the message,” as recited in claim 1. Moreover, no other portion of Gudjonsson constitutes a teaching of the

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missing element. Accordingly, Applicants respectfully request the allowance of claim 1. By virtue of their dependence from claim 1, claims 2-4 are also allowable.

For the same reason, Gudjonsson fails to teach at least “configuring a connection for the at least one communication device based on information in the message,” as recited in claim 5, “means for configuring a connection for the at least one communication device based on information in the message,” as recited in claim 9. Furthermore, by virtue of their dependence from claims 5, 9, and 13, dependent claims 6-8, and 10-12 are also allowable.

Independent claim 13 recites a combination including, for example, “means for configuring a connection for establishing the telephone calls to the user.” The Examiner has asserted that this claim is anticipated by Gudjonsson; Applicants respectfully disagree. As discussed with reference to claim 1, the “invitation” of Gudjonsson is not a “connection.” Accordingly, even assuming Gudjonsson teaches configuring the receipt of an invitation, such configuring cannot constitute “means for configuring a connection for establishing the telephone calls to the user,” as recited in claim 13. Applicants, therefore, respectfully request the allowance of claim 13. By virtue of their dependence from claim 13, claims 14-16 are also allowable.

Rejections under 35 U.S.C. § 103(a)

The rejection of claim 17 as unpatentable under 35 U.S.C. § 103(a) is respectfully traversed, since the Examiner has not made a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, each of three requirements must be met. First, the reference or references, taken alone or in combination, must teach or suggest each and every element recited in the claims. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in

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the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” (See M.P.E.P. § 2143 (8th Ed. 2001)). Applicants submit that these requirements have not been met for at least the following reasons.

The Examiner rejected claim 17 under 35 U.S.C. § 103(a) over Gudjonsson in view of Matthews. Applicants respectfully traverse this rejection for at least the following reasons.

First and foremost, Applicants submit that the Examiner has failed to set forth a *prima facie* case of obviousness, because the Examiner has failed to allege any suggestion for combining Gudjonsson with the speech processor of Matthews. In the Office Action, the Examiner merely stated that “[i]t would have been obvious to one skilled in the art at the time the invention was made to modify Gudjonsson et al to have the “receiving a … speech processor,” as taught by Matthews et al such that the modified system of Gudjonsson al [sic] would be able to support the speech processor to the system users.” See O.A. at pp. 5-6. Applicants submit that this rejection amounts to no more than a conclusory assertion that the combination is obvious, without any identified motivation, absent that in Applicants’ own disclosure, to motivate such a combination. Accordingly, Applicants submit that this falls far short of a *prima facie* case for obviousness.

Moreover, even if the combination suggested by the Examiner were made, such combination neither teaches nor suggests combined elements including, “configuring a connection for the at least one communication device based on the information in the call,” as recited in claim 17. As discussed above, with regard to claim 1, Gudjonsson does not teach or suggest this element, because an “invitation” cannot constitute a “connection.” Furthermore,

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Matthews fails to cure this deficiency, because, it too fails to teach or suggest such an element.

Accordingly, no combination of Gudjonsson and Matthews can render claim 17 obvious, and Applicants, therefore request its timely allowance.

Conclusion

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-17 in condition for allowance. Applicants submit that the proposed amendments of claims 1, 5, 9, 13, and 17 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

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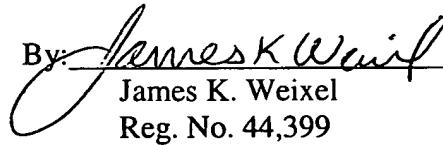
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Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 07-2339.

Respectfully submitted,

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